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RE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number:
12258-036001

I hereby certify that this correspondence is being transmitted by facsimile to the Patent and Trademark Office on the date indicated below.

September 14, 2005

Signature

Irja Zarembok

Application Number

10/615,279

First Named Inventor

Jeff Korn

Art Unit

3737

Filed

July 8, 2003

Examiner

William C. Jung

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SD/96)
☒ attorney or agent of record.
Registration number 41,942
☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34

Signature

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Telephone number

September 14, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of Pages are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Jeff Korn
Serial No. : 10/615,279
Filed : July 8, 2003
Title : OPTICAL COUPLER FOR ROTATING CATHETER

Art Unit : 3737
Examiner : William C. Jung

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-16 are pending, with claims 1 and 10 being independent. Claims 1-16 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by *Alfano*, U.S. Patent No. 6,208,886. Reference is hereby made to the arguments already of record regarding the failure to establish anticipation; see the response to the first office action, filed on March 16, 2005, at pages 5-6 and the response to the final office action, filed on June 22, 2005, at pages 3-4.

The presently claimed subject matter, as exemplified in claim 1, is directed to a way to couple a stationary housing to a rotating catheter that has a collection fiber and a delivery fiber extending through it. A difficulty that arises is that the collection fiber revolves around an axis of

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rotation. The delivery fiber extends along the catheter's axis of rotation, and therefore does not trace out an orbit as does the collection fiber.

One face of the housing has two ports, each port receiving light from one of the two fibers. One of these ports is a central port, which is at the center of the housing. This central port couples to the delivery fiber. The other port, which is not at the center, couples to the collection fiber. This port, since it is not at the center, is called the "eccentric" port. Within the housing is a lens that captures the light from the collection fiber even as the light traces out an orbit as the catheter spins. This lens focuses this orbiting beam of light to a fixed location.

The Examiner has interpreted "eccentric" in two different ways. One way is that of deviating from a norm, as in "an eccentric uncle." The second way is that of being located off-center.

With regard to the first interpretation, Applicant pointed out that since "eccentric" refers to deviation from a norm, somewhere there must be a definition of what the norm is. In the advisory action, the Examiner places the burden of defining the norm on the Applicant and states that since the Applicant has not defined a norm, the configuration of ports shown in *Alfano* can be considered "eccentric" in the sense of deviating from the norm.

To anticipate a claim, the cited reference must show all the claim limitations. Thus, if *Alfano* discloses an eccentric, in the sense of "unusual," port, the fact that it is "unusual" must be apparent from *Alfano*. It makes no sense to say that *Alfano* describes an unusual port because Applicant's disclosure omits a definition of what a "usual" port is.

The Examiner's logic appears to be as follows:

1. *Alfano* discloses a port.
2. Applicant's specification does not describe a "usual" port.

3. Therefore, *Alfano's* port must be an unusual (i.e. "eccentric") port.

This makes no logical sense since the conclusion could just as well be that *Alfano's* port is not unusual (i.e. not "eccentric"). Whether *Alfano's* port is "unusual" or not is a fact that cannot be changed by Applicant's specification. Therefore, Applicant's specification can have no bearing on whether the *Alfano* port is unusual or not.

Although the Examiner is entitled to the broadest reasonable interpretation of a term in a claim, the word "reasonable" is there for a reason. The proposed interpretation of "eccentric" as meaning "different from a norm" is manifestly unreasonable because there is no basis in the specification for such an interpretation. Moreover, the interpretation is inconsistent with the Examiner's interpretation of "central" in the first paragraph of claim 1:

a housing with a rotatable distal face and a stationary proximal face, the distal face having an eccentric port and a central port

Since the Examiner has interpreted "central" to mean a spatial position, it makes sense for "eccentric" to also be interpreted as a spatial position. This is far more consistent with the specification, which shows a port located at the center, and a port located off-center.

With regard to the second interpretation, the Examiner appears to consider the tube in FIG. 9 of *Alfano* to be the claimed housing. The face of each fiber in the tube, shown in cross section in FIG. 9, is allegedly a "port." Thus, paragraph 1 of claim 1 is interpreted as follows:

a housing [**tube**] with a rotatable distal face [?] and a stationary proximal face [?], the distal face having an eccentric port [**detection fiber**] and a central port [**excitation fiber**]

However, there is no indication in *Alfano* that the tube has a rotatable distal face and a stationary proximal face. As best as can be determined, the entire tube is intended to be stationary.

The identification of ports with the faces of fibers also appears improper. As disclosed in the specification, "port" means an opening in the housing that is intended to receive a fiber. The plain meaning of "port" is an opening or passageway. Thus, the term "port" would more properly correspond to the boundary between the tube's lumen and the free space beyond. The fact that a fiber can cross this boundary on its way into this lumen does not make the fiber a "port" any more than the fact that a person can walk through a doorway makes the person into a doorway.

The Examiner perhaps considers the face of the fiber to be a "port" because light can enter the fiber through the front face. But the Examiner has already identified the housing with the tube in FIG. 9. Thus, if one adopted this reasoning, the "port" would no longer be a port on the distal face of the *housing* as required by the claim. Instead, it would simply be a port on the distal face of the *fiber*.

Claim 1 also recites

a lens disposed *inside the housing* to intercept a rotating collection beam emerging from the eccentric port and to re-direct the collection beam to a focus proximal to the lens as the collection beam rotates;

The Examiner has identified a micro-lens in FIG. 9 that is on top of the fiber tips. However, there is no indication that this lens is *inside* the tube. Nor is there any indication that the fibers rotate so that the lens can intercept a *rotating* collection beam and redirect it to a focus as the collection beam rotates.

Alfano refers to a rotating mirror in FIG. 11. However, this is irrelevant because the claims recite a *housing* with a rotatable distal face, not a mirror that rotates.

In view of the above, all of the claims should be in condition for allowance. A formal notice of allowance is thus respectfully requested.

Applicant : Jeff Korn
Serial No. : 10/615,279
Filed : July 8, 2003
Page : 5 of 5

Attorney's Docket No.: 12258-036001

Payment for the notice of appeal is enclosed. No additional fees are believed to be due in connection with the filing of this request for review. However, to the extent fees are due, or if a refund is forthcoming, please adjust our deposit account 06-1050, referencing attorney docket "12258-036001."

Respectfully submitted,

Date: September 14, 2005



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